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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,520	05/31/2000	Claude M. Leglise	INTL-0391-US (P8805)	1973
7590	02/19/2004		EXAMINER	
Timothy N Trop Trop Pruner & Hu PC Suite 100 8554 Katy Freeway Houston, TX 77024			RETTA, YEHDEGA	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 02/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/584,520

Applicant(s)

LEGLISE ET AL.

Examiner

Yehdega Retta

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ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-16 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-16 and 18-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

***Response to Amendment***

This office action is responsive to amendment filed September 12, 2003.

***Response to Arguments***

Applicant's arguments filed December 5, 2003 have been fully considered but they are not persuasive.

Applicant's argument is that the office action contends that Erickson article (Netsurfer) teaches controlling the ability of the customer to add software or hardware to a processor-based system. Applicant's argues that nothing in the article is cited because there is no support within the article. The Applicant called upon the examiner to cite the specific language within the article. Examiner cites below the specific language taught by the article.

Netsurfer states "SoftCast is a technology, written by Netsurfer using Internet standards, that allows the ISP to push content to a user's computer and make changes to that computer" (see page 78 col. 3 under SOFTCAST). Netsurfer also states, "The ISP can use SoftCast to push software updates, marketing materials, news or account queries to the subscriber. It can also fix problems on the subscriber's computer including registry errors or software bugs" (see page 80 col. 1 lines 1-6). Further Netsurfer state "Because it is built using industry-standard protocols, SoftCast can also update any third-party software on the user's machine, such as word processors, spreadsheets or games" (see page 80 col. 1. lines 28-40). To push content or software updates to a user computer indicates that the ability of customer to add software or hardware.

Applicant also requests the examiner to cite a reference in support to a well-known art. Examiner have already supplied a prior art in support to the Official Notice taken, with the Advisory Action, paper number 6, mailed on August 21, 2003.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-16, 18-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Netsurfer as taught by "Netsurfer makes it easy" Broadwatch Magazine ; Todd Judd Erickson January 2000, in view of "ZipLink's Virtual Internet Service Provider (ISP) Program Provides complete Turnkey Outsourcing Option PR Newswire; New York; Nov 4, 1999 (hereinafter ZipLink).

Regarding claim 1, Netsurfer teaches providing signup CD to ISP, with everything on it, branded by an ISP; providing Internet service through graphical user interface provided by the service provider (ISP) (see page 76 col. 3, page 78 col. 2 and 3). Netsurfer teaches ISPs using branded interface can provide user access to the web, and direct access to the ISP's content partners (see page 76 col. 2 and 3). using the SoftCast the ISP pushes content to a user computer and makes changes to the computer and pushes software updates, ... and can also fix problems

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including errors and software bugs... and update thirdparty software (see 78 and 80). Netsurfer however does not teach providing Internet services to customer through a service provider, on behalf of retail vendors, it is disclosed in Ziplink (see page 1). Ziplink teaches providing private-branded Internet connectivity, which enables e-businesses, affinity groups and web-centric organizations, etc. to become Virtual ISPs. Ziplink teaches that the service includes custom sign-up, activation and authentication, billing and collection, branded CD, e-mail and news service, etc. Ziplink teaches by using the system customers avoid the tremendous investment of building and maintaining a national network and the cost of staffing a customer care operation center (see page 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Netsurfer's signup platform and Ziplink's branded Internet service. One would be motivated to provide private-branded Internet service to e-business (retail vendors) that enable them to become Virtual ISPs since outsourcing the connectivity or service and customer care function enables the customers (vendors) to concentrate on building their business and avoid the tremendous investment of building and maintaining a national network, as taught by Ziplink (see page 1). Netsurfer does not teach providing customized advertising to the client based on preferences received from the client. Official notice is taken providing customized advertising to said client based on preferences received from the client is old and well known in the art of marketing. One would be motivated to provide customized advertising based on user preference in order to develop a one-to-one relationship with the user, by providing a targeted content.

Regarding claim 2, Netsurfer teaches customizing the content provided based on the customer's identity (see page 78 col. 3 and page 80 col. 1-3)

Regarding claim 3, Netsurfer teaches controlling the initial graphical user interface displayed after booting of the system (see page 78 col. 1 and 2). Netsurfer teaches, once the customer place the CD in the computer the signup program uses wizards to guide the user through the account creation and network connection processes (see page 78).

Regarding claim 4, Netsurfer does not teach providing confidential information to service provider instead of retail store. Ziplink teaches the Virtual ISP program offering a full suite of customer card management services including customer sign-up, activation and authentication, which indicate that all the back-end services including authentication being performed by the Virtual ISP (see page 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Netsurfer's sign-up program with Ziplink's Virtual ISP program. One would be motivated to provide confidential information to the Internet service provider instead of the retail vendor since the service provider is the one who is performing the authentication.

Regarding claim 5, Netsurfer teaches providing the customer with a predefined set of selection (see page 80 and fig. 2&3).

Regarding claim 6, Netsurfer teaches enabling the service provider to provide control software and hardware added to user computer (see page 78 and 80 Col. 1). *Netsurfer teaches controlling the ability of the customer to add software or hardware. Netsurfer states "SoftCast is a technology, written by Netsurfer using Internet standards, that allows the ISP to push content to a user's computer and make changes to that computer"(see page 78 col. 3 under SOFTCAST). Netsurfer also state "The ISP can use SoftCast to push software updates, marketing materials, news or account queries to the subscriber. It can also fix problems on the subscriber's computer including registry errors or software bugs" (see page 80 col. 1 line 1-6).*

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***Further Netsurfer state "Because it is built using industry-standard protocols, SoftCast can also update any third-party software on the user's machine, such as word processors, spreadsheets or games" (see page 80 col. 1. lines 28-40).***

Regarding claim 8, Netsurfer teaches receiving the customer preference on customer computer coupled to the service provider over the Internet, forwarding the customer preference to the service provider, customizing the content based on the information (see page 80). 9.

Regarding claim 9, Netsurfer teaches automatically directing the customer to a server associated with retail vendor when the customer wishes to obtain a product or service offered by the retail vendor (see page 78 Col. 2&3). Netsurfer teaches any ISP can have a branded desktop with its own channels and content partners and the ISP-branded interface can provide user access the web and a direct access to the ISP's content partners (retail vendors) (see page 78, col. 2&3 and fig. 1).

Regarding claim 10, Netsurfer teaches service provider uses desktop application to control what the user sees and when, and provides e-commerce companies space on the desktop application (see page 78). Netsurfer teaches advertising included on a home page (see fig. 1). Netsurfer does not teach the advertising is related the vendor, which the Internet service provider is providing service for. Ziplink teaches the Virtual ISP program being designed to complement an organization's marketing and customer retention efforts (see page 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Netsurfer' desktop which includes advertisement and Ziplink's Virtual ISP program. One would be motivated to include advertising related to the vendor, in order to allow the vendor to provide targeted content to the subscribers. Official notice is taken that is old and well known in the art

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of Internet service to provide more than two graphical user interfaces for user to access the service. It would have been obvious to one of ordinary skill in the art at the time of the invention to require more than two graphical user interfaces before accessing the vendor site for the purpose of providing the user a first page, log-in page, to allow user login to the service provider's site and a second page, homepage, to allow the user to select a site he/she would like to access.

Regarding claim 11, Netsurfer teaches providing signup CD to ISP, with everything on it, branded by the ISP; providing Internet service through graphical user interface provided by service provider (see page 76 col. 3, page 78 col. 2 and 3). Netsurfer teaches ISPs using branded interface can provide user access the web, and direct access to the ISP's content partners (see page 76 col. 2 & 3). Netsurfer teach preventing the customer from accessing the Internet services from the service provider. Netsurfer teaches controlling the ability of the customer to add software or hardware. Netsurfer teaches using the SoftCast the ISP push content o a user computer and make changes to the computer and to push software updates, ...and can also fix problems including errors and software bugs... and update thirdparty software (see 78 and 80). Netsurfer however does not teach providing Internet services to customer through a service provider, on behalf of retail vendors, it is disclosed in Ziplink (see page 1). Ziplink teaches providing private-branded Internet connectivity, which enables e-businesses, affinity groups and web-centric organizations, etc. to become Virtual ISPs. Ziplink teaches that the service includes custom sign-up, activation and authentication, billing and collection, branded CD, e-mail and news service, etc. Ziplink teaches by using the system customers avoid the tremendous investment of building and maintaining a national network and the cost of staffing a customer



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care operation center (see page 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Netsurfer's signup platform and Ziplink's branded Internet service. One would be motivated to provide private-branded Internet service to e-business (retail vendors) that enable them to become Virtual ISPs since outsourcing the connectivity or service and customer care function enables the customers (vendors) to concentrate on building their business and avoid the tremendous investment of building and maintaining a national network, as taught by Ziplink (see page 1). Netsurfer does not teach providing advertising, to the client based on customer's preferences. Official notice is taken to provide customized advertising to said client based on preferences received from the client is old and well known in the art of marketing. One would be motivated to provide advertising based on user preference in order to develop a one-to-one relationship with the user, by providing a targeted content.

Regarding claim 21, Netsurfer teaches a processor and a storage coupled to the processor (customer computer), the storage storing instructions that enable the processor to obtain Internet services. Netsurfer teaches providing signup CD to ISP, with everything on it, branded by the ISP (see page 76 col. 3, page 78 col. 2 and 3). Netsurfer teaches when the Signup CD is loaded on user's computer the system posts the data to a server that sets up a user account, to provide Internet service (see page 78 col. 1&2). Netsurfer teaches using branded interface provides the user access to the web, and direct access to the ISP's content partners (see page 76 col. 2 and 3). Netsurfer teach loading the signup CD preventing the customer from accessing the Internet services from the service provider. Netsurfer teaches controlling the ability of the customer to add software or hardware. Netsurfer teaches using the SoftCast the ISP push content o a user

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computer and make changes to the computer and to push software updates, ...and can also fix problems including errors and software bugs... and update thirdparty software (see 78 and 80). Netsurfer however does not teach providing Internet services to customer through a service provider, on behalf of retail vendors, it is disclosed in Ziplink (see page 1). Ziplink teaches providing private-branded Internet connectivity, which enables e-businesses, affinity groups and web-centric organizations, etc. to become Virtual ISPs. Ziplink teaches that the service includes custom sign-up, activation and authentication, billing and collection, branded CD, e-mail and news service, etc. Ziplink teaches by using the system customers avoid the tremendous investment of building and maintaining a national network and the cost of staffing a customer care operation center (see page 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Netsurfer's signup platform and Ziplink's branded Internet service. One would be motivated to provide private-branded Internet service to e-business (retail vendors) that enable them to become Virtual ISPs since outsourcing the connectivity or service and customer care function enables the customers (vendors) to concentrate on building their business and avoid the tremendous investment of building and maintaining a national network, as taught by Ziplink (see page 1). Netsurfer does not teach receiving, information about preferences and providing advertising to the client based on preferences received form the client. Official notice is taken to provide advertising to said client based on preferences received form the client is old and well known in the art of marketing. One would be motivated to provide customized advertising based on user preference in order to develop a one-to-one relationship with the user, by providing a targeted content.

Claims 12 and 22 are rejected as stated above in claim 2.

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Claim 13 is rejected as stated above in claim 3.

Claims 14, 23 and 24 are rejected as stated above in claim 4.

Claim 15 is rejected as stated above in claim 5.

Claim 16 is rejected as stated above in claim 6.

Claims 18, 26 are rejected as stated above in claim 8.

Claim 19 is rejected as stated above in claim 9.

Claim 20 is rejected as stated above in claim 10.

Regarding claim 25, Netsurfer teaches storing instruction that enable the system to control the initial graphical user interfaces from being changed (see page 78 col. 1&2).

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Regarding claim 27, Netsurfer teaches user computer, which includes housing and display (see page 78 col. 1).

### ***Conclusion***

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yehdega Retta  
Examiner  
Art Unit 3622

YR